

REMARKS

Status of the claims

Claims 1-5 and 7 were previously canceled.

Claim 6 is pending and under consideration.

Claim Rejections – 35 U.S.C. §103

The Examiner has maintained the rejections from the previous Office Action (mailed October 16, 2006) of claim 6 under 35 U.S.C. 103(a) as being unpatentable over USP 5,720,406 (Fassbind et al.) in view of USP 6,776,964 ('964, Wijnschenk et al.) and USP 4,226,333 (Percarpio).

The Examiner again asserts that it would have been obvious to one skilled in the art to provide the closures in Fassbind with recesses as shown in the '964 (Wijnschenk) as a matter of design choice (Final Action page 3).

The Examiner has not provided any suggestion or motivation for either Wijnschenk or Fassbind to alter their closure design in any manner; there was no problem left to be solved in either design that would have been mitigated by the modifications provided by the other reference. The Examiner states "the motivation to combine the closure of Wijnschenk with the vessels in Fassbind comes from the disclosure that the closures in Wijnschenk are for sealing test tubes, similar to the test tubes in Fassbind" (Final Action page 5). Simply the fact that both references relate to "test tubes" is not sufficient evidence to provide motivation to alter the functionality of closure design. The Examiner has not provided any motivation for either Wijnschenk or Fassbind to modify their designs when their current designs already function well for their intended purposes. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" (*KSR Int'l co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1791 (2007) quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Additionally, the Examiner again asserts that it would have been obvious to one skilled in the art to provide the tool (34) in Percarpio with the closure in the '964 (Wijnschenk) patent with the container in Fassbind in view of the tool's known use (Final Action page 3).

The Examiner has not provided any suggestion or motivation for Wijnschenk to utilize the closure tool of Percarpio; the design of Wijnschenk does not employ a closure tool and already functions well for the intended purposes. In fact, Wijnschenk teaches away from using a closure tool by describing the use of tools as being a “disadvantage”. Wijnschenk discloses: “A further disadvantage {of the prior art} is that tools must be used if an individual (single) sealing element has to be fitted” (Wijnschenk column 1 lines 31-32). This description of “fitting” of the sealing element clearly relates to the seating of the element into the mouth of a test tube. No tools are required or even suggested in Wijnschenk in order to achieve fitting of the sealing element as disclosed. The Examiner has not provided any motivation for Wijnschenk to employ the additional step of using a tool when the current design does not require it. Therefore the Examiner has not provided an apparent reason for one skilled in the art to combine the tool of Percarpio with the closure of Wijnschenk, additionally with the container in Fassbind. The Examiner must show that “there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit”. (*KSR Int’l Co. v. Teleflex Inc.*, at 1741).

Applicants assert that the Examiner has not established a *prima facie* case of obviousness for the reasons stated above. The Examiner has failed to make an explicit analysis of reasons to combine the cited elements. Applicants respectfully assert that, in the absence of such analysis, the Examiner has relied upon the teachings of the instant invention in order to interpret and combine the cited art. The KSR case has specifically instructed courts to “guard against slipping into the use of hindsight”. (*KSR Int’l Co. v. Teleflex Inc.*, at 1742 quoting *Graham v. John Deere Co.*, 383 US 1, 36 (1966)).

Applicants respectfully request the reconsideration and withdrawal of the §103 rejections of claim 6.

CONCLUSION

Applicants respectfully request entry of the present RCE and remarks. In view of the above, Applicants believe all claims now pending in this Application are in condition for allowance.

Applicants respectfully request a 2-month extension of time to respond to the Final Office Action mailed June 4, 2007. The response date was September 4, 2007; with the granting of this request, the response time is re-set to November 4, 2007. The commissioner is hereby authorized to charge the amount of \$460, the fee due under 37 CFR §1.17(a)(2), and the amount of \$810, the fee due under 37CFR §1.114, to Deposit Account No. 50-0812.


Please grant any additional extensions of time that may be required to enter this amendment and charge any additional fees or credit any overpayments to Deposit Account No. 50-0812.

Please direct all future correspondences to: Customer No. 22829.

Respectfully submitted,

Date: October 25, 2007

By:


Rhea C. Nersesian
Reg. No. 55,488

Correspondence Address

Roche Molecular Systems, Inc.
1145 Atlantic Avenue
Alameda, California 94501
Tele: 510-814-2800
Fax: 510-814-2973